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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,377	04/20/2004	Erik A. Knight	014208.1642 (93-03-020)	4825
35005	7590	09/08/2008	EXAMINER	
BAKER BOTTS L.L.P.			STERRETT, JONATHAN G	
2001 ROSS AVENUE, 6TH FLOOR				
DALLAS, TX 75201-2980				
			ART UNIT	PAPER NUMBER
			3623	
			NOTIFICATION DATE	DELIVERY MODE
			09/08/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/828,377	<b>Applicant(s)</b> KNIGHT, ERIK A.	
	<b>Examiner</b> JONATHAN G. STERRETT	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4-20-04; 4-21-06</u>  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Summary*

1. This **Non-Final Rejection** is responsive to 20 April 2004. Currently Claims 1-20 are pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 7-12 and 19** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Claims 7** is rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory

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process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, **Claim 7** is non-statutory since it may be performed within the human mind. Claims 8-12 depend on Claim 7 and are thus similarly rejected.

**Claim 19** recites a reporting tool that is comprised of means for. Since the means for may be only software, not embodied on a computer readable medium, these limitations may be implemented on software per se, which is considered printed matter and not statutory re 101.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bloomfield**, Charles; "Bringing the Balanced Scorecard to Life: The Microsoft Balanced Scorecard Framework", White Paper, Insightformation, Inc., published May 2002, pp.1-34. (hereinafter **Bloomfield**) in view of **Mouritsen**, et.al. "Valuing the Future: intellectual capital supplements at Skandia", November 4, 2001, Accounting Auditing & Accountability Journal, Vol. 14, No. 4, pp.399-422 (hereinafter **Mouritsen**)

Regarding **Claim 1**, Bloomfield teaches:

**A reporting tool for reporting innovation data, comprising: a database operable to store innovation data, the innovation data comprising information about one or more innovation capabilities of an entity;**

Page 19 para 4, data from a data warehouse;

**and a processor coupled to the database and operable to:**

**retrieve the innovation data;**

page 19 para 4, data is retrieved from the data warehouse, i.e. using SQL Server™ (i.e. a processor since this software is known to run on a computer).

**process the innovation data according to at least one of a plurality of metrics, the plurality of metrics representing one or more innovation goals corresponding to the entity;**

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para 21 para 1 and 2, the data retrieved is processed so that analyses can be made

**determine a user role; and generate a report for the entity according to the user role, the report comprising the processed innovation data.**

Page 16, the portal is personalized;

Page 17, Figure 3, the portal provides a report of the processed data.

Bloomfield teaches that a scorecard is an important tool for communicating and measuring how a company is measured in strategic issues important for that company's success. Bloomfield does not teach where the balanced scorecard addresses innovation issues per se (i.e. deals with innovation data).

Mouritsen teaches the need to measure the intellectual capital of a company, where the intellectual capital includes things like investments in R&D(page 403 para 1). Mouritsen teaches that the measuring of intellectual capital of a company is important in ensuring that the company is successful (see page 399 para 2). Furthermore, Skandia's intellectual capital statements (see page 404) suggest that these statements are based on data that is known regarding activities that can be measured within the company. These statements are provided within Skandia's financial report. Thus the prior art of Mouritsen by suggesting that innovation data can be presented in statements that are provided in an annual report suggests that these teachings are combinable with

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Bloomfield, who teaches in a broader context the advantages and need to provide balanced scorecards that address issues of strategic performance within a firm.

One of ordinary skill in the art would thus modify the teachings of Bloomfield to include where the balanced scorecard includes innovation data as taught by Mouritsen, because it would provide a way to measure the innovation capability of a company using the well-known balanced scorecard of Bloomfield.

Regarding **Claim 2**, Bloomfield teaches:

**2. The reporting tool of Claim 1, the processor further operable to retrieve the innovation data by: accessing at least one of a plurality of data sources using a directory, the directory indicating the location of at least a portion of the innovation data;**

Page 19 para 1 and 2, templates for gathering data from various sources is a directory of data sources – since these data sources are electronic – these templates indicate the location.

**retrieving the at least a portion of the innovation data; and updating the database with the at least a portion of the innovation data.**

Page 19 para 1, the data being captured is managed in a database – i.e. this implies that this data is stored in the database.

Regarding **Claim 3**, Bloomfield teaches:

**3. The reporting tool of Claim 1, wherein the plurality of metrics comprises at least one of a budget allocated for innovation, a number of submitted ideas, a number of patent applications, a number of patents issued, a number of acquired trademarks, and a licensing revenue.**

Page 20 Figure 5 shows a scoreboard that illustrates data being illustrated as metric values (i.e. numbers).

Regarding **Claim 4**, Bloomfield teaches:

**4. The reporting tool of Claim 1, the processor further operable to process the innovation data according to the at least one of the plurality of metrics by:**

**identifying the at least one metric associated with an innovation program of the entity;**

page 21 para 1, the average measure for a particular metric (e.g. on-time delivery) is identified.

**associating a weight with each of the at least one metric; and**

page 21 para 1, since the average is taken, this implies a weighted of 1 is associated with the particular metric.

**determining a status of the innovation program according to the at least one weight.**



Page 21 para 1, the status of the particular program being measured is determined according to the status compared to a threshold.

Regarding **Claim 5**, Bloomfield teaches:

**5. The reporting tool of Claim 1, the processor further operable to generate the report for the entity according to the user role by generating a web-based display that illustrates at least some of the innovation data.**

Page 20 Figure 5, This figure shows a web-based report that illustrates the data being measured.

Regarding **Claim 6**, Bloomfield teaches:

**6. The reporting tool of Claim 1, wherein the user role is associated with a level of access to the innovation data.**

Page 10 No 3; page 16 Facet 1, the level of access (i.e. a personalized portal) is associated with a level of access, since it provides data that shows how that person supports the overall strategy.

**Claims 7-20** recite similar limitations to those addressed by the rejection of **Claims 1-6** above, and are therefore rejected under the same rationale.

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***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Measure success

Noah Schachtman. InformationWeek. Manhasset: Oct 26, 1998. , Iss. 706; pg. 103, 3 pgs

Harnessing the power of intellectual capital. (includes glossary and list of reference materials) Bassi, Laurie J. Training & Development, v51 , n12, p25(6) Dec, 1997, Dialog 10018565 Supplier Number: 20251749.

D'Allesandro US 6,556,974 teaches a method for evaluating business performance.

Honarvar US 6,321,206 teaches a method for moving business clients across a variety of strategic categories.

Zamanian US 6,339,775 teaches a method for extracting business information from data warehouses for business analytical applications.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan G. Sterrett whose telephone number is 571-272-6881. The examiner can normally be reached on 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGS 8-27-2008

/Jonathan G. Sterrett/

Primary Examiner, Art Unit 3623

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